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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,276	11/27/2001	David B. Donahue	10547-0020-999	2346

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THE DIRECTV GROUP INC  
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EXAMINER

NAWAZ, ASAD M

ART UNIT PAPER NUMBER

2155

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/996,276	Applicant(s) DONAHUE ET AL.	
	Examiner Asad M. Nawaz	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. This action is responsive to the amendment filed on May 23, 2005.

Independent claims 1, 17, and 19 were amended. Dependant claim 13 has been amended to overcome 35 USC. 112 issues. Claims 21-27 have been newly added.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6, 8, and 11-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Bullman et al (US Patent No. 6,778,505), hereinafter referred to as Bullman.

As to claim 1, Bullman teaches a method for the automatic configuration of a bi-directional Internet Protocol (IP) communication device, comprising:  
broadcasting a request for basic configuration details for the IP communication

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device, where said request contains a unique bi-directional IP communication device identifier associated with a unique user; (Abstract; cols 2 and 3, lines 64-67 and 1-39; Bullman teaches a system and method in which the basic configuration details for an IP communication device are broadcast. The protocol determination, driver setting, and optimization of the physical layer settings are intended to be utilized by the IP device)

receiving said basic configuration details from a server, where said basic configuration details are assigned to said unique user based on said unique bi-directional IP communication device identifier; (Fig 4; col 3, lines 28-32)

and configuring said bi-directional IP communication device with said basic configuration details. (col 3, lines 20-28)

Claims 17 and 19 are essentially the communication device and the computer program product of the above mentioned method claim and are thus rejected under the same rationale.

Claims 22 and 26 are contain essentially the same limitations as claim 1 and claim 16 and are thus rejected under similar rationale.

As to claim 2, Bullman teaches the method of claim 1, wherein said broadcasting further comprises broadcasting said request for basic configuration details, including an IP address, to a Dynamic Host Configuration Protocol (DHCP) server, where said bi-directional IP communication device is a Digital Subscriber Line (DSL) gateway. (Abstract; col 2, lines 54-63; col 4, lines 52-67; col 5, lines 1-30)

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Claims 18 and 20 are essentially the communication device and the computer program product of the above mentioned method claim and are thus rejected under the same rationale.

As to claim 3, Bullman teaches the method of claim 2, wherein said receiving comprises obtaining an IP address from said DHCP server. (col 4, lines 52-67; col 5, lines 1-30)

As to claim 4, Bullman teaches the method of claim 1, further comprising transmitting a configuration request for additional configuration details. (col 5, lines 20-47)

As to claim 5 Bullman teaches the method of claim 4, further comprising receiving said additional configuration details specific to said unique user. (col 5, lines 20-47)

As to claim 6, Bullman teaches the method of claim 5, further comprising configuring said bi-directional IP communication device with said additional configuration details. (col 3, lines 20-32; col 5, lines 49-67)

As to claim 8, Bullman teaches the method of claim 1, further comprising, before said broadcasting step, the step of automatically detecting a DSL communication circuit. (col 2, lines 53-63)

As to claim 11, Bullman teaches the method of claim 1, wherein said broadcasting comprises broadcasting a DHCP Discover request. (col 4, lines 52-63)

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As to claim 12, Bullman teaches the method of claim 1, wherein said receiving comprises acquiring a DHCP Offer message from a DHCP server. (col 4, lines 46-57)

As to claim 13, Bullman teaches the method of claim 1, further comprising, prior to said configuring step, the steps of: sending a DHCP Request message to said DHCP server and receiving a DHCP acknowledge message from said DHCP server. (cols 4 and 5, lines 46-67 and 1-30)

As to claim 14, Bullman teaches the method of claim 1, wherein said broadcasting and receiving steps occur automatically without any communication between said bi-directional IP communication device and a client computer coupled to said bi-directional IP communication device. (Abstract; cols 2 and 3, lines 53-67 and 1-45)

As to claim 15, Bullman teaches the method of claim 1, further comprising, prior to said configuring step, the steps of: assigning said unique bi-directional IP communication device identifier to said bi-directional IP communication device; and associating said unique bi-directional IP communication device identifier with said unique user. (col 4, lines 52-67; col 5, lines 1-30)

As to claim 16, Bullman teaches the method of claim 15, further comprising generating a configuration table listing bi-directional IP communication device identifiers and associated users. (col 6, lines 50-60)

Claims 21 and 23 contain similar limitations as the above-mentioned claim and are thus rejected under similar rationale.

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As to claims 25 and 27, Bullman teaches a method comprising before said broadcasting step, the step of automatically detecting a dial-tone for the internet protocol.(inherent)

As to claim 24, Bullman teaches a method comprising wherein said basic configuration details for the IP communication device include an IP address. (inherent because as taught by Fig 2 and its accompanying explanation in col 2 and 3, Bullman teaches packets being transmitted via TCP/IP protocol stack. It is known in the art that a TCP packet header contains both source and destination addresses.)

5. Claims 1, 17, 19, 22, and 26 are rejected under 35 U.S.C. 102(e) as being taught by Hughes USPN 6,854,009.

As to claims 1, 17, 19, 22, and 26, Hughes teaches a method for the automatic configuration of a bi-directional Internet protocol communication device, comprising providing a bi-directional IP device having a unique device identifier, associating the device identifier with a user identifier for a unique user of the IP communication device, and providing the IP device to the unique user (abstract; fig 14; col 4, lines 12-25; col 23, lines 43-67).

Providing the device identifier and the user identifier to an internet service provider (abstract)

Generating a configuration table listing device identifiers, their associated users and each user's basic configuration details and storing the configuration

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table in a server; (Figs 10a-10G; Fig 14; abstract; col 23, line 22 to col 24, line 50)

Connecting the IP communication device to a network at a user site;  
(abstract)

Broadcasting a request for basic configuration details for the IP device to the server over the network, where said request contains unique device ID identifying the user's basic configuration details in the configuration table from the device identifier, and transmitting the configuration details to the user site device. (col 2, lines 2-65)

Receiving the configuration details from the server and configuring said IP device with said basic configuration details.(abstract; col 23, lines 43-67)

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bullman et al (US Patent No. 6,778,505), hereinafter referred to as Bullman further in view of Official Notice.



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.As to claim 7, Bullman teaches the method of claim 1, further comprising, before said broadcasting step, the steps of: connecting said bi-directional IP communication device to an analog telephone line;(col 2, lines 53-67)

However, Bullman does not explicitly indicate that the said bi-directional IP communication device is powered on.

Official Notice is taken that it would have been obvious to one of ordinary skill in the art at the time of the invention to power the device on prior to usage.

As to claim 9, Bullman teaches the method of claim 1, step of automatically determining connection details for communications between said bi-directional IP communication device and a communications network.(col 2 and 3, lines 53-67 and 1-30; col 4, lines 47-52)

However, Bullman does not explicitly indicate the connection being a PVC.

Official Notice, as evident by Microsoft's Computer Dictionary 5<sup>th</sup> Edition, is taken that It would have been obvious to one of ordinary skill in the art at the time of the invention to use a PVC connection in order to make the system more efficient. Data transmitted on a common carrier connection, such as one provided by a DSL provider or a telephone company, appears to be a dedicated link and thus there is no wait time for transmission of data (collision detection, token, etc.).

8. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bullman et al (US Patent No. 6,778,505), hereinafter referred to as Bullman,

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further in view of Hassan-Ali et al (US Patent No 6,778,542) hereinafter referred to as Hassan-Ali.

As to claim 10, Bullman teaches the method of claim 9, however does not explicitly indicate the step of ascertaining a VPI/VCi (Virtual Path Identifier/Virtual Channel Identifier) pair for said communications.

Hassan-Ali teaches the step of ascertaining a VPI/VCi (Virtual Path Identifier/Virtual Channel Identifier) pair for said communications. (col 13, lines 17-33)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Hassan-Ali into those of Bullman to make the system more flexible. VPIs and VCIs only have local significance and can be easily implemented with translation tables. Furthermore, VPI/VCi pair allows identifiers to be re-used. This becomes a necessity due to their limited size. VPI/VCi pairs are known to be used within ATM networks, a capability that is taught by Bullman.

### ***Response to Amendment***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asad M. Nawaz whose telephone number is (571) 272-3988. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



AMN



SALEH NAJJAR  
PRIMARY EXAMINER